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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/458,813	12/10/1999	Brian R. Murphy	17634-000330US	9312

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NATIONAL INSTITUTES OF HEALTH  
OFFICE OF TECHNOLOGY TRANSFER  
6011 EXECUTIVE BLVD SUITE 325  
ROCKVILLE, MD 20852-3804

EXAMINER

CHEN, STACY BROWN

ART UNIT	PAPER NUMBER
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1648

DATE MAILED: 04/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/458,813

Applicant(s)

MURPHY ET AL.

Examiner

Stacy B. Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 53-85 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 53-85 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 December 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Applicant's amendment filed February 15, 2006 is acknowledged and entered. Claims 53-85 remain examination.

#### ***Claim Rejections - 35 USC § 112***

2. Claims 67, 68 and 83-85 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims are drawn to chimeric viruses, specifically wherein the substitution mutation at position 456 of the L protein is "to another amino acid". The breadth of the claims has not been adequately described such that one of skill in the art would know how to practice the invention.

The specification describes a mutation wherein the amino acid at position 456 of PIV3 is changed to leucine. However, Applicant's claims encompass a substitution of any of the 20 amino acids. To provide adequate written description and evidence of possession of a claimed genus, the specification must provide sufficient distinguishing identifying characteristics of the genus. The factors to be considered include disclosure of complete or partial structure, physical and/or chemical properties, functional characteristics, structure/function correlation, methods of making the claimed product, or any combination thereof. In this case, the only factor present in the claim is one example (456 F) out of 20 possibilities and no particular function. Accordingly,

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in the absence of sufficient recitation of distinguishing identifying characteristics, the specification does not provide adequate written description of the claimed genus.

Applicant's arguments have been carefully considered but fail to persuade. Applicant argues that the Federal Circuit states that a sequence need not appear in a patent specification to support a DNA-based invention provided that the state of the scientific knowledge at the time the application was filed includes such structural information. Applicant cites *Capon et al. v. Eshhar et al. v. Dudas*, 76 USPQ2d 1078 (Fed. Cir. 2005). Applicant argues that the skilled artisan would be fully aware of the structure of the genus of polypeptides claimed. Applicant asserts that the skilled artisan would merely have to replace the nucleotide sequence encoding an amino acid at the specific location recited in the claims with any of the well-known nucleotide sequences that encode the desired amino acid.

In response to Applicant's arguments, the examiner has considered *Capon et al. v. Eshhar et al. v. Dudas*, 76 USPQ2d 1078 (Fed. Cir. 2005). *Capon et al.* and *Eshhar et al.* disclosed the sequences of those that were to be recombined. The Fed Circuit noted in section [1], that "since written description requirement must be applied in context of particular invention and state of knowledge, and there is no per se rule that nucleotide sequence must be recited anew when that information is already known in art, since invention at issue lies not in discovering which DNA segments are related to immune response, but in novel combination of segments to achieve novel result, since claimed chimeric genes are prepared from known DNA sequence of known function, and since requirement that these sequences be analyzed and reported in specifications therefore does not add descriptive substance."

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In this case, Applicant has provided a base structure in which the nucleotides encoding an amino acid are to be substituted for the naturally occurring nucleotides encoding a different amino acid. In *Capon et al. v. Eshhar et al. v. Dudas*, the sequences to be combined were provided in full. Applicant has provided the nucleotides to be substituted into the base structure, and points to the known nucleotides that are available which encode amino acids. The Office assumes that Applicant is referring to at least the 60 codons that encode the 20 common amino acids: gca, gcc, gcg, gcu, ugc, ugu, gac, gau, gaa, gag, uuc, uuu, gga, ggc, ggg, ggu, cac, cau, aua, auc, auu, aaa, aag, uua, uug, cua, cuc, cug, cuu, aug, aac, aaU, cca, ccc, ccg, ccu, caa, cag, aga, agg, cga, cgc, cgg, cgu, agc, agu, uca, ucc, ucg, ucu, aca, acc, acg, acu, gua, guc, gug, guu, ugg, uac and uau.

While the sequences are provided in full, as in *Capon et al. v. Eshhar et al. v. Dudas*, the function of the substituted codon is not known. In *Capon et al. v. Eshhar et al. v. Dudas*, the invention of Capon does not concern the discovery of gene function or structure, but are prepared from known DNA sequences of known function. On this point, *Capon et al. v. Eshhar et al. v. Dudas*, and the instant application differ.

In this case, the function of the codons in the base structure is not known. Applicant has failed to provide a structure/function nexus between the substituted codon (structure) and its desired function (attenuation). For Applicant to claim a genus of substitutions for which Applicant has not given a starting point, one of skill in the art would need to discover which of gca, gcc, gcg, gcu, ugc, ugu, gac, gau, gaa, gag, uuc, uuu, gga, ggc, ggg, ggu, cac, cau, aua, auc, auu, aaa, aag, uua, uug, cua, cuc, cug, cuu, aug, aac, aaU, cca, ccc, ccg, ccu, caa, cag, aga, agg, cga, cgc, cgg, cgu, agc, agu, uca, ucc, ucg, ucu, aca, acc, acg, acu, gua, guc, gug, guu, ugg, uac

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and uau, is an attenuating mutation. In other words, if Applicant had provided a nexus, such as hydrophilic amino acids can be substituted for position 456 of the L protein, one of skill in the art would be able to have a connection between the substitution and the function of attenuation.

Applicant has not provided this. Therefore, the claims remain rejected for reasons of record.

3. The rejection of claims 62, 77-80 and 84-85 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, is withdrawn in view of Applicant's amendment to the claims, correcting "995", which accidentally introduced new matter. The amendment to "996" has overcome the rejection.

#### ***Claim Rejections - 35 USC § 102***

4. The rejection of claims 53-57, 59-66, 69-73, 75, 81, 82 and 85 under 35 U.S.C. 102(e) as being anticipated by Belshe *et al.* (US 5,869,036, "Belshe"), is withdrawn in view of Applicant's persuasive arguments.

With regard to the claims that recite, "said partial or complete PIV genome or antigenome comprising a polynucleotide encoding a wild-type L protein of the PIV", the limitation distinguishes the claims from Belshe. Applicant argues, and the examiner agrees that Example 5 is directed to a complementation assay, wherein the L gene (among others) was introduced into a plasmid. CV-1 cells were co-transfected with the plasmid vector pRSV-T and one or more recombinant plasmids, such as the L gene. Twenty-four hours post-transfection, the expressing cells were infected with cp45 virus. Based on this complementation assay, Belshe concludes that cp45 viruses complemented with the wild-type L protein, produced by the cell,

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are capable of replicating at the non-permissive temperature for the cp45 virus (col. 16, lines 54-62). The wild-type L gene is not incorporated into the genome (as required by the claims).

With regard to the claims that specify the type of insertion into the PIV genome, the limitation distinguished over Belshe. Applicant argues, and the examiner agrees that Belshe discloses hybrid genomes that are derived by substituting the regions encoding F and HN proteins of cp45 with cDNA copies of corresponding genes of a target virus (Belshe, col. 9, lines 54-59 and col. 10, lines 19-22). Applicant argues that the substitution replaces the gene segment normally present at the same location, not between two open reading frames within or encompassing an ORF. Claim 181, for example, recites, "said heterologous gene(s) or genome segment(s) being inserted into the PIV genome or antigenome at one or more site(s) selected from the group consisting of a site between the P and M open reading frames, a site between the N and P open reading frames, a site between the HN and L open reading frames and a site between the 3' leader and the N open reading frame." Belshe does not teach or suggest insertion of heterologous genes between open reading frames, rather, replacing native reading frames with heterologous ones (substitution). Therefore, the rejection is withdrawn.

### ***Claim Rejections - 35 USC § 103***

5. The rejection of claims 58, 68, 74 and 84 under 35 U.S.C. 103(a) as being unpatentable over Belshe, is withdrawn in view of the Applicant's persuasive arguments which are addressed above.

***Double Patenting***

6. Claims 53-85 remain provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 144-215 of copending Application No. 09/083,793. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter of the copending application is encompasses the embodiments set forth in the instant claims. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 53-85 remain provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-30 and 46-74 of copending Application No. 09/459,062. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter of the copending application is encompasses the embodiments set forth in the instant claims. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claims 53-85 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 84-163 of copending Application No. 09/586,479. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter of the copending application is encompasses the embodiments set forth in the instant claims. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.



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9. Claims 53-85 remain provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 180-222 of copending Application No. 09/733,692. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter of the copending application is a species of the instantly claimed genus of PIVs, rendering the genus claims obvious. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

10. No claim is allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stacy B. Chen whose telephone number is 571-272-0896. The examiner can normally be reached on M-F (7:00-4:30). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James C. Housel can be reached on 571-272-0902. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



Stacy B. Chen  
Primary Examiner  
April 17, 2006